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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/149,448	09/09/1998	MICHAEL S. BATTAGLIA	264-146	5036

23117 7590 04/23/2003

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EXAMINER

BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 04/23/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

84

# Office Action Summary

Application No.

09/149,448

Applicant(s)

Battaglia et al.

Examiner

Boccio, Vincent

Art Unit

2615

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.

- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.

- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.

- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Feb 10, 2003

2a) ☒ This action is **FINAL**.

2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-31 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 1-31 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

5) ☐ Notice of Informal Patent Application (PTO-152)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

6) ☐ Other:

**DETAILED ACTION**

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 2615.

**Claim Rejections - 35 USC § 112**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:  
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
2. Claims 1-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

All the claims recite, "palm sized", but applicant fails to have support for this newly amended limitation, relating to the size of a portable palm sized hand held digital camera data transfer and repository device".

Applicant fails to cite supporting sections of the specification to support the newly presented claims.

The original specification, page 1, hand held battery powered, therefore, portable, but, fails to support "palm sized".

Page 4, further fails to support the recited limitations, by merely reciting:

**"preferably is of a size which can be comfortable held in a user's palm and which is lightweight and readily portable",**

this passage as well as the drawings etc....., also fail to support the limitation of wherein the repository device, is of the size, which is, "PALM SIZED", there exists no clear support for the size limitation, as claimed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito et al. (US 6,256,063) in view of Yamauchi et al. (US 6,020,982) and Endsley et al. (US 6,005,613).

Regarding claims 1 and 7, Saito discloses and meets the limitations associated with

a portable, hand held, transfer and repository device a housing of a size to be held in a user's palm (Fig. 1, "Laptop Computer", being a portable user's computer), which comprises a mass storage device, the Laptop has storage for storing images from a camera memory card for off-loading of the memory card, wherein the repository has a screen for displaying at least part of the contents (col. 10).

Saito fails particularly disclose wherein the repository device is, "Palm Sized" and wherein the device is used between a camera, memory card, to device, to a user's computer.

Yamauchi also teaches the concept of having a transfer repository device or filing device 500 (Figs. 51-52, 60), which is used to transfer from memory card 400 to filing device 500, wherein this filing device is associated with an editing machine wherein the card type connector 504 can also be installed in the editing machine 600, and data can be exchanged, wherein as taught by Yamauchi, the filing device for off-loading is desirable to be extremely small and reduction of size and weight is promoted, as taught by Yamauchi.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Saito by incorporating the teaching of Yamauchi to make the repository device, smaller and lighter and wherein the editing device, for further transfer of images, the combination fails to address the wording "Palm Sized", although suggested to be small and lightweight, by the combination as applied.

The combination as applied suggests that repository devices, should be small, lightweight and portable, but, as claimed fails to particularly describe, the size, as PALM sized, but, it would have been obvious an obvious matter of design choice to reduce the size to, "Palm Sized", since such a modification would have

involved a mere change in the size of a component or housing.

A change in size is generally recognized as being within the level of ordinary skill in the art.

In re Rose, 105 USPQ 237 (CCPA 1955).

Regarding claims 2, 6, 8-31, the analysis of last action is incorporated by reference(Saito in view of Yamauchi), wherein the limitations corresponding to claims 25-31, have been analyzed and met by the previous claims limitations identified previously.

Further regarding the claims 1-31, the combination as applied fails to address, providing a user's computer as an addition associated device and wherein as claimed in claim 3 etc., utilizing a USB type interface between.

The examiner cites Endsley et al., which shows the utilization of USB I/F 14, a HOST computer 12 with monitor 16 and camera, in Fig. 1, known to be well known in the art, the Universal Serial Bus is well known by others besides Endsley {Official Notice}, wherein, it would have been further obvious to those skilled in the art at the time of the invention to utilize USB and a computer, associated with a digital camera and some sort of repository device and a user's or a personal computer as is obvious and clearly implied to those skilled in the art, which provides versatility, wherein the user's computer can store, edit etc., send images to printers, perform cropping or other, send pictures thru, WEB, E mail or CD R, as are well known.

Response to Arguments

5. Applicant's arguments with respect to the amended and newly presented claims 1-31, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Fax Information

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communication intended for entry)

**or:**

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Contact Information

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7. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Vincent F. Boccio (703) 306-3022, Monday-Thursday 6:30 am to 5:00 pm.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vin  
April 21, 2003

  
VINCENT BOCCIO  
PRIMARY EXAMINER